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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/596,315	Applicant(s) SKINSTAD ET AL.	
	Examiner Jaime Cardenas-Navia	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 15 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/09/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Introduction

1. This **NON-FINAL** office action is in response to communications received on June 9, 2006. Claims 1-12 have been amended. Claims 13 and 14 have been cancelled. Claims 15 and 16 have been added. Claims 1-12, 15, and 16 are currently pending.

Priority

2. Applicant's claim for priority to foreign application SWEDEN 0303367-7 filed on 12/12/2003 has been granted.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 06/09/2006 has been considered by the Examiner.

Specification

4. **The disclosure is objected to** because of the following informalities:

There are many grammatical errors throughout the specification, such as p. 3, lines 3 and 21, p. 4, lines 13, 14, and 16, p. 5, line 7, p. 9, lines 7, 15, 16, 20, and 23, and p. 10, line 11.

These and all other errors must be corrected.

Claim Objections

5. **Claims 1, 3, 8, 11, 12, and 15 are objected to** because of the following informalities:

Regarding claim 1, the hyphens from the terms 'num-ber' and 'is-suing' should be removed. Also, 'an global interconnected network' should be amended to 'a global interconnected network,' and 'is adapted examine' should be amended to 'is adapted to examine.'

Regarding claim 3, 'a purchase, provide information' should be amended to 'a purchase, to provide information.' Also, the hyphen from 'man-aging' should be removed.

Regarding claim 8, 'the' should be removed from 'the amount.'

Regarding claims 11, 12, and 15, the hyphens from the terms 'net-work,' 'in-formation,' and 'is-sued' should be removed.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-12, 15, and 16 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 11, 12, and 15, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. There are two instances, both of which have been removed for purposes of examination. See MPEP § 2173.05(d).

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Regarding claims 1-12, 15, and 16, 'the server' lacks antecedent basis. Applicant must use consistent terminology, which Examiner believes means always using 'the managing server.'

Regarding claims 3, 5, and 7-9, 'the second communication terminal' lacks antecedent basis, as these dependent claims don't claim priority to claim 2, which introduces the term 'a second communication terminal.'

Regarding claim 8, 'the cost' and 'the corresponding amount' lack antecedent basis. They should be amended to 'a cost' and 'a corresponding amount,' respectively.

Regarding claim 9, 'the specific requirements' lacks antecedent basis. 'the' should be removed.

Regarding claims 4, 5, 9, and 10, 'the purchasing organization' lacks antecedent basis, and an appropriate first instance should be added into claim 1.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. **Claims 12, 15, and 16 are rejected** under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 12, a “computer program” per se does not fall into one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter). Software, programming, instructions or code not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in a computer. When such

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descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases. Furthermore, software, programming, instructions or code not claimed as being computer executable are not statutory because they are not capable of causing functional change in a computer. In contrast, when a claimed computer-readable medium encoded with a computer program defines structural and functional interrelationships between the computer and the program, and the computer is capable of executing the program, allowing the program's functionality to be realized, the program will be statutory.

For purposes of examination, the claims have been interpreted as a properly claimed computer-readable medium. Examiner notes that claim 15 is a computer-readable medium.

Regarding claims 15 and 16, the claimed 'computer program product' could include signals. Signals and waves are considered non-statutory subject matter. To overcome this rejection, Examiner recommends amending the claims to explicitly state that the computer program product does not transmit (propagate) signals.

For purposes of examination, Examiner has assumed that necessary corrections have been made.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 1-12, 15, and 16 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Heimermann et al. (US 2002/0143692 A1) in view of Official Notice.

Regarding claim 1, Heimermann teaches an apparatus for managing purchases in progress which are made by a number of individuals belonging to a liable organization (abstract), the apparatus comprising

a managing server (100) connected to an global interconnected network (105), the managing server including a storage means (140) and issuing means (150) (fig. 1-6, par. 191, network, Internet, par. 310, 312, 313, database, par. 237, System has issuing means to alert supplier of successful bid and provide relevant information (shipping, tracking, payment, etc.), par. 256, 257, issuing means, packing slip),

a client terminal (130) connected to the network for providing information to the storage means of the managing server about purchasing rules for individuals purchasing on behalf of an organization (par. 242, provision for specification to the System of rules as to payment release, par. 314-318),

the issuing means adapted to generate digital certificates, the digital certificate being issued and distributed to a purchasing individual, in dependence on purchasing rules (par. 104, 295-300, and 350, also tracking and shipping info, par. 27, par. 257, packing slip),

a first communication terminal (120) operated by a provider is adapted to, in response to a purchase, provide information to the managing server relating to a purchase in progress (par. 242, system receives qualifying data and releases payment, par. 265-267, supplier notifies System if there is a problem with the purchase, par. 320-328, request for bid in response to request for purchase, suppliers bid in response to a purchase request), wherein

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the managing server is adapted to examine whether information provided is in accordance with the purchasing rules, as a result of which a notification is sent to the first communication terminal so as to validate the purchase (par. 242, system receives qualifying data and releases payment, par. 265-267, supplier notifies System if there is a problem with the purchase, par. 320-328, request for bid in response to request for purchase, suppliers bid in response to a purchase request, notification of acceptance of bid).

Heimermann does not explicitly teach the issuing means adapted to generate a unique number, the number being issued and distributed to a purchasing individual, in dependence on purchasing rules.

Official Notice is given that generating a unique number and distributing it is old and well-known. In the field of procurement, unique numbers often must be generated in order to differentiate and track orders.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the teaching of digital certificates, which often take the form of unique numbers and achieve the same result (par. 104, 295-300).

Regarding claim 2, Heimermann teaches wherein the issuing means is adapted to generate a digital certificate, the certificate being issued and distributed to a second communication terminal operated by a purchasing individual, in dependence on the purchasing

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rules (par. 104, 295-300, and 350, also tracking and shipping info, par. 27, par. 257, packing slip, sent to system, CPA officials).

Heimermann does not explicitly teach wherein the issuing means is adapted to generate a unique number, the number being issued and distributed to a second communication terminal operated by a purchasing individual, in dependence on the purchasing rules.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the teaching of digital certificates, which often take the form of unique numbers and achieve the same result (par. 104, 295-300).

Regarding claim 3, Heimermann teaches wherein the second communication terminal operated by a purchasing individual could be adapted to, in response to a purchase, provide information to the managing server relating to a purchase in progress (par. 197-205, purchase validation).

Regarding claim 4, Heimermann teaches wherein the client terminal is operated by the purchasing organization (par. 54, 199, client terminal is part of System, operated by purchasing organization (e.g. gov't organization)).

Regarding claim 5, Heimermann teaches wherein as a result of the examination, the managing server sends a notification also to the purchasing organization in addition to the notification to the first and/or second communication terminal (par. 205, 238-240, reports,

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System (operated by purchasing organization) stores all info in database and can be viewed as reports).

Regarding claim 6, Heimermann does not explicitly teach wherein the unique the number includes a logical part and a random part, the logical part including at least one of organization, department, individual and serial number of issued numbers, and the random part being any four digit number.

Official Notice is given that many methods of generating unique numbers composed of various parts are old and well-known in the art. Random parts are very common, as well as an indication of the department or individual often comprises this unique identifying information.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the teaching of digital certificates, which often take the form of unique numbers and achieve the same result (par. 104, 295-300), as well as the teaching of different departments within organizations (par. 3) and identifying individual purchasers (par. 34).

Regarding claim 7, Heimermann does not explicitly teach wherein the unique number is distributed to the second communication terminal either via a smart card or by printing the unique number on a purchasing coupon, preferably in the form of a bar code.

Official Notice is given that embodying data in both smart cards and bar codes are old and well-known in the art.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the teaching of distributing the unique information through e-mail notifications, packing slips, or online input (par. 84, 257, 253).

Regarding claim 8, Heimermann teaches wherein the information provided from the first and/or second communication terminal to the managing server relating to a purchase includes unique order information and a cost of the purchase for reservation of a corresponding amount on a debiting account (par. 253, 257).

Heimermann does not explicitly teach wherein the information provided from the first and/or second communication terminal to the managing server relating to a purchase includes the unique number and a cost of the purchase for reservation of a corresponding amount on a debiting account.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the teaching of order information, which generally includes a unique number to identify the purchase (par. 257).

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Regarding claim 9, Heimermann teaches wherein for valid purchase, the first and/or second communication terminal connects to an electronic invoicing service (175), which is adapted to execute invoicing in accordance with specific requirements for payment of the purchasing organization (par. 242, e-invoices).

Regarding claim 10, Heimermann teaches wherein the electronic invoicing service is adapted to connect to the managing server for retrieval of specific routines stored thereon for invoicing relating to the purchasing organization (par. 242, e-invoices).

Regarding claims 11, 12, and 15, they are rejected using the same art and rationale used above for rejecting claim 1. This is because claims 11, 12, and 15 claim a method, computer program, and computer program product, respectively, for performing the functions of the apparatus of claim 1.

Regarding claim 16, Heimermann does not explicitly teach wherein the computer readable medium is a propagated signal and the propagated signal is a carrier wave.

Official Notice is given that embodying a computer program in a propagated signal is old and well-known in the art.

All the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions. The claimed invention is merely a combination of old and well-known elements, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention. Thus, it would have been obvious to combine the teachings, motivated by the well-known distribution advantages of embodying software in signals.

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Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Gryglewicz et al. (US 6,993,502 B1) teaches a system and method for computing and collecting taxes, which includes applying rules to transactions.

Chikirivao et al. (US 2003/0163783 A1) teaches business rules and notifications.

Hendrix et al. (US 2003/0182206 A1) teaches intelligent management of accounts payable electronic processing, including rules, notifications, cost-verification, and significant automation.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaime Cardenas-Navia whose telephone number is (571)270-1525. The examiner can normally be reached on Mon-Fri, 10:30AM - 7:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./

Examiner, Art Unit 3624

May 7, 2010

/Romain Jeanty/

Primary Examiner, Art Unit 3624